



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,121	06/14/1999	MICHAEL E. PALMER	50269-026	3744

7590 05/23/2003

BRAIN D HICKMAN
HICKMAN PALERMO TROUNG & BECKER LLP
1600 WILLOW STREET
SAN JOSE, CA 95125-5106

EXAMINER

BIENEMAN, CHARLES A

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,121

Applicant(s)

PALMER ET AL.

Examiner

Charles A. Bieneman

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communication: Amendment filed on April 28, 2003.
2. Claims 1-34 are pending. Claims 1 and 34 are independent claims.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. **Claims 1-14, 17-19, and 26-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,835,905 to Pirolli et al. (hereinafter "Pirolli"), issued November 10, 1998, filed April 9, 1997, in view of U.S. Patent Number 5,960,422 to Prasad (hereinafter "Prasad"), issued September 28, 1999, filed November 26, 1997.

With respect to each of claims 1-14, 17-19, and 26-34, the rejection made in the Office action mailed on January 24, 2002 is fully incorporated herein by reference.

5. **Claims 15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirolli and Prasad in view of U.S. Patent Number 6,282,549 B1 to Hoffert et al. (hereinafter "Hoffert"), issued August 28, 2001, filed March 29, 1999.

With respect to each of claims 15 and 16, the rejection made in the Office action mailed on January 24, 2002 is fully incorporated herein by reference.

6. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pirolli and Prasad in view of U.S. Patent Number 6,128,606 to Bengio et al. (hereinafter "Bengio"), issued October 3, 2000, filed March 11, 1997.

Art Unit: 2176

With respect to claim 20, the rejection made in the Office action mailed on January 24, 2002 is fully incorporated herein by reference.

7. **Claims 21-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirolli and Prasad in view of U.S. Patent Number 6,389,436 to Chakrabarti et al. (hereinafter "Chakrabarti"), issued May 14, 2002, filed December 15, 1997.

With respect to each of claims 21-25, the rejection made in the Office action mailed on January 24, 2002 is fully incorporated herein by reference.

Response to Arguments

8. Applicant's arguments filed April 28, 2003 have been fully considered but they are not persuasive.

Regarding independent claims 1 and 34, applicants argue on pages 5-6 that Pirolli does not teach the claim limitation of "determining how strongly each document . . . corresponds to each of said plurality of categories by determining similarity between each said document and the documents that belong to the training set of the category" (page 5), because Pirolli does not teach the feature of "using a particular set of documents established as belonging to a category to determine the correspondence between the document and the category." (Page 6.)

The argument summarized in the preceding paragraph is spurious inasmuch as the Office action mailed on January 24, 2002 stated on page 3 that "Pirolli does not disclose determining similarity between each document and the training documents that belong to the training documents that belong to the training set of each category." Rather, in addressing the claim limitation now at issue the rejection in the earlier Office action (which has been maintained in the present Office action) posited a combination of Pirolli and Prasad.

Art Unit: 2176

Applicants next argue (page 6) that Pirolli “seems to teach against such a feature because of the types of functional categories it discloses.” However, just because Pirolli discloses different kinds of categories and categorization than what is claimed by applicants does not mean that Pirolli teaches against their claimed invention.

Applicants further argue that “Prasad fails to teach the claimed feature of using similarity between a document and another set of documents established as belonging to a category to determine the correspondence between the document and the category.” (Page 6.) The basis for applicants’ contention is that Prasad “teaches that training sets are used for rule induction” but does not suggest that “training sets are used [to] determine the correspondence between a document and the category to which the training set belongs by determining the similarity between the document and the training set.” (Page 7.) The examiner disagrees with applicants’ characterization of Prasad inasmuch as the rule induction taught by Prasad is used to classify documents, *i.e.*, determine their similarity to a category. (Prasad, col. 4, lines 3-16.)

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2176

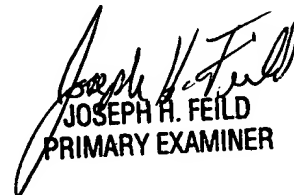
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB
May 8, 2003


JOSEPH H. FEILD
PRIMARY EXAMINER